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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

KIRIL A. PANDELISEV

Serial No.: 09/880,943

Art Unit: 1731

Filed: June 15, 2001

Examiner: C. Lopez

For: HOT SUBSTRATE DEPOSITION OF FUSED SILICA PROCESS AND APPARATUS

RESPONSE

To the Director of Patents and Trademarks

Sir:

In response to the office action dated February 24, 2004, applicant provisionally elects Species Y and B and traverses the requirement.

The species are substantially identical, and generic claims are allowable.

Claims 109-216 read upon the elected Species Y, and claims 109-122, 128-148, 177-191, inter alia, read upon the elected species.

Restriction should not be required. The invention is unitary.

The inventions as described in the claims are neither independent nor distinct. In fact, the inventions as claimed arise from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be

required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP 802.01 points out that a sub-combination and a combination are not independent inventions, and that a process and an apparatus used in the practice of the process are not independent inventions. That same section points out that independent means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon his holding that the subjects are distinct. That is, as pointed out in Section 802.01, the examiner has held that the subject matter as claimed:

are capable of separate manufacture, use or sale as claimed,
AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under Section 803 that the claimed inventions:

are able to support separate patents and they are ...
distinct (MPEP Section 806.05-806.05(i)).

However, Section 803 unequivocally states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

So that Section 803 makes its point clearly, the serious burden requirement is repeated under the title:

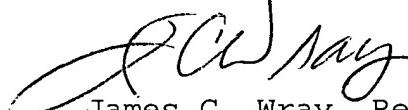
CRITERIA FOR RESTRICTION BETWEEN
PATENTABLY DISTINCT INVENTIONS

Section 803 goes on to state that there are two criteria for a restriction requirement: one, that the inventions must be distinct as claimed; and two, that there must be a serious burden on the examiner if restriction were not required.

Section 803 goes on to state under GUIDELINES that an examiner must provide reasons and/or examples to support conclusions. The examiner has never stated that there would be a serious burden on the examiner if restriction were not required. Indeed, there should be no serious burden on the examiner.

Reconsideration and allowance of the application are requested. Reconsideration and withdrawal of the restriction requirement are requested.

Respectfully,



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